

REMARKS/ARGUMENTS

The Applicants have carefully considered this application in connection with the Office Action and respectfully request reconsideration of this application in view of the foregoing amendment and the following remarks.

The Applicants originally submitted Claims 1-15 in the application. Claims 6 and 12-15 were cancelled pursuant to a first restriction requirement. Claims 7-11 were withdrawn pursuant to a second restriction requirement. Claims 19-20 were withdrawn by the Office in the April 16 Action. In previous responses, Claims 1, 3-5, and 7-11 were amended, Claim 2 was cancelled, Claims 16-21 were added and Claims 22 and 23 were added and simultaneously withdrawn. In this response, the Applicants amend Claims 1, 4, 5, 19 and 20 without prejudice or disclaimer, and add new Claims 24-26. Accordingly, Claims 1, 3-5, 7-11 and 16-26 are currently pending in the application, and Claims 1, 3-5 and 16-18, 21 and 24-26 are currently subject to examination.

I. Withdrawal of Claims 19 and 20

The Office has withdrawn Claims 19 and 20, asserting that these claims are directed to an invention that is independent or distinct from the invention originally claimed. (*See* page 2.) This withdrawal is improper. Rule 145 states that “[i]f ... the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed....” (Emphasis added.) Claims 19 and 20 as examined depended from Claims 1 and 19, respectively. (Claim 20 is amended herein to depend from Claim 1.) Therefore, the assertion that these claims are not independent from the invention previously claimed is illogical and incorrect. Because the claims are not distinct from and

independent of the invention previously claimed, a requirement for restriction is improper. Accordingly the Applicants respectfully request that the Office restore Claims 19 and 20 to active status and examine these claims on their merits.

II. Rejection of Claims 1, 3-5, 16-18 and 21 under 35 U.S.C. § 112, first paragraph

The Office rejects claims 1, 3-5, 16-18 and 21 under 35 U.S.C. § 112, first paragraph, asserting that the specification does not reasonably enable the claimed invention. (*See* page 2.) The Applicants respectfully submit that the claims as amended herein meet the enablement requirement under 35 U.S.C. § 112, first paragraph. For example, Claim 1 includes the limitation “wherein said fluid is controllable to reversibly change a degree of penetration of said feature pattern by said electrolyte liquid.” This inventive feature is enabled by the Applicants’ specification which discloses, for instance, that electrowetting or a reduction of pressure in a cell of the feature pattern, *e.g.*, by reducing the temperature of a fluid within the feature pattern, may increase penetration of the feature pattern by the electrolyte liquid. (*See, e.g.*, page 10, lines 10-12, 15-17 and 28-30 of the specification as filed.) The fluid may be, *e.g.*, the electrolyte liquid or a gas. (*See, e.g.*, page 10, lines 7-9.) The electrolyte liquid may also be expelled from the cell, *e.g.*, by controllably heating the fluid within the feature pattern. (*See, e.g.*, page 11, lines 5-8; 10-14.)

Accordingly, the claimed invention is enabled, thereby meeting the requirements of § 112, first paragraph. The Applicants respectfully request the Office to withdraw the rejection of Claims 1, 3-5, 16-18 and 21 under § 112, first paragraph and allow issuance thereof.

III. Double Patenting Rejection

The Office rejects Claims 1, 3-5, 16-18 and 21 based on a non-statutory double patenting rejection over Claims 1-11 of U.S. Patent No. 7,227,235 to Kroupenkine, *et al.* The Applicants respectfully submit that the claims as amended herein are patentably distinct from the claims of the Kroupenkine patent. Specifically, the Applicants assert that the element of Claim 1, “wherein said fluid is controllable to reversibly change a degree of penetration of said feature pattern by said electrolyte liquid” is not obvious in light of the teaching of Kroupenkine. (Emphasis added.) Accordingly, the Applicants respectfully request the Office to withdraw the double patenting rejection and grant allowance of pending claims 1, 3-5, 16-18 and 21.

The Applicants acknowledge the provisional rejection of Claims 1, 3-5, 16-18 and 21 on the ground of non-statutory obviousness double patenting over Claims 5-7 of copending Application No. 10/803,565. The Applicants respectfully defer a substantive response to the provisional rejection until such time that the rejection ripens to a non-provisional rejection.

IV. New Claims

New Claims 24-26 are submitted herewith for examination. These claims are supported, *e.g.*, at page 10, line 7-9 and lines 15-17 of the Specification as filed. The Applicants respectfully assert that these claims are novel and nonobvious over the references of record as currently applied.

V. Conclusion

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1, 3-5 and 16-18, 21 and 24-26.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in black ink, appearing to read 'DHH', is written over the printed name of David H. Hitt.

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